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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,363	11/16/2001	Kenneth G. De Souza	9794.00	5597

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,363

Applicant(s)

DE SOUZA ET AL.

Examiner

James S McClellan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 9-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to the social sciences) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 9-10 fail to apply, involve, use, or advance the technological arts. It is noted that method claims 1-8 and 11-13 all include a transponder which the feature that uses the technological arts. The method of claims 9-10 can be carried out manually.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-8 and 14-21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,513,015 (Ogasawara).

Regarding **claim 1**, Ogasawara discloses a method, comprising at a portal to enclosure, receiving an identity signal from a transponder (see paragraph bridging columns 8-9); locating an account, based on the identity signal (see column 8, lines 4-16); creating a change in the account (see column 13, lines 38-55); **[claim 2]** the transponder is carried by a person (see Figure 1); **[claim 3]** the change in the account is beneficial to the person (see column 13, lines 38-55); **[claim 4]** the identity signal is invisible to third parties (inherent); and **[claim 5]** no social interaction with the person accompanies locating the account (inherent because account identification is electronic).

Regarding **claim 6**, Ogasawara discloses a method, comprising at a portal to an enclosure, receiving an identity signal from a transponder carried by a person (see paragraph bridging columns 8-9); and issuing an award to a party identified by the identity signal (see column 13, lines 38-55); **[claim 7]** the party identified is identical to the person (inherent); and **[claim 8]** the award is accompanied by no social interaction with the person at the time the

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identity signal is received from the transponder (inherent because account identification is electronic).

Regarding **claim 14**, Ogasawara discloses a system as set forth in claim 1. **Claims 15-18** are similar to claims 2-5 and are rejected for the same reasons as described above in detail.

Regarding **claim 19**, Ogasawara discloses a system as set forth in claim 6. **Claims 20-21** are similar to claims 7-8 and are rejected for the same reasons as described above in detail.

5. Claims 9, 10, 22 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. US 2003/0078864 (Hardesty et al.).

Regarding **claim 9**, Hardesty et al. discloses a method, comprising maintaining a score of bonus points for a customer (see paragraph 0007); detecting entry of the customer through a portal (consumers “visit” certain websites via a portal); and in response to the entry, increasing the score (see paragraph 0007); and [**claim 10**] the step of detecting entry is accomplished with no social interaction with the customer (inherent because account identification is electronic).

Regarding **claim 22**, Ogasawara discloses a system as set forth in claim 9. **Claim 23** is similar to claim 10 and is rejected for the same reasons as described above in detail.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 11, 13, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara in view of Hardesty et al.

Regarding **claims 11 and 13**, Ogasawara fails to explicitly disclose transmitting a message to a location in response to the identify signal.

Hardesty et al. teaches awarding an incentive in response to the identify signal of a user, when the user merely “visits” the retail store (in this case electronically, see paragraph 0007) and further teaches sending a message to the person and a third party which results in modification of a monetary account of the person (see paragraph 0046).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ogasawara with a response to the identify signal as taught by Hardesty et al., because providing an incentive for a customer to merely “visit” or enter the store attracts customers to the store, wherein inherently increasing the likelihood that the person will make a purchase.

Regarding **claim 24**, Ogasawara and Hardesty et al. disclose a system as set forth in claim 11. **Claim 26** is similar to claim 13 and is rejected for the same reasons as described above in detail.

8. Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara in view of Hardesty et al. as applied to claims 11 and 24 above, and further in view of U.S. Patent No. 5,903,880 (Biffar).

Regarding **claim 12**, Ogasawara in combination with Hardesty et al. show all the claimed elements as set forth above except for the use of the message comprises an e-mail message addressed to the person.

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Biffar teaches the use of e-mailing incentive/loyal award information (see column 16, lines 49-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ogasawara with e-mail notification of loyalty information, because e-mailing account information will allow users to keep track of potential awards or incentives.

Regarding **claim 25**, Ogasawara, Hardesty et al., and Biffar disclose a system as set forth in claim 12.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

French et al. is cited of interest for disclosing a cart return loyalty credit system.

Chen is cited of interest for disclosing a loyalty file structure for a smart card.

Herz et al. is cited of interest for disclosing a location enhanced information delivery system.

Kolls is cited of interest for disclosing an in-vehicle data communication system for processing e-commerce.

Ashery et al. is cited of interest for disclosing a system for collecting information associated with movement between locations.

Ogasawara is cited of interest for disclosing a system for customer recognition using wireless identification and visual data transmission.

Smith is cited of interest for disclosing a location tracking of individuals in physical spaces.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

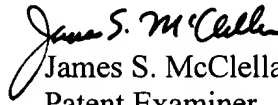
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872-9326 (Official communications - Before Final);
(703) 872-9327 (Official communications - After Final); or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Patent Examiner
A.U. 3627

jsm
September 30, 2003